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APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/849,022	(05/04/2001	Joseph D. Gold	091/005P	7806	
22869	7590	04/27/2005		EXAMINER		
GERON CO			TON, THAIAN N			
230 CONSTI MENLO PAI				ART UNIT PAPER NUMBER		
WENEO I'I	idi, Oi	, 6.1 7.025		1632	<u></u>	
				DATE MAILED: 04/27/2005		

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief Art Unit Thaian N. Ton 1632 The REPLY FILED 07 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. 1 The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal To avoid abandonment on this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal or in compliance with 37 CFR 1.11; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods: a) The period for reply expiresmonths from the mailing date of the final rejection. b) The period for reply expires one (1) the mailing date of the final rejection. c) The period for reply expires one (1) the mailing date of the final rejection. Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO. Extensions of time may be obtained under 37 CFR 1.316(a). The date on which the petition under 37 CFR 1.316(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of eventsion and the corresponding amount of the fice. The appropriate extension fee have been filed is the date for purposes of determining the period of eventsion and the corresponding amount of the file. The appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and the appropriate extension fee under 37 CFR 1.316(a) and 31 control of the date of filing in the Notice of Appeal and 50 CFR 1.316(a) (a) The present addition of the appeal (37 CFR 4.337(a) (a) and 31 control of th	4			
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 2. ☑ The Notice of Appeal was filed on <u>08 November 2004</u>. A brief in compliance with 37 CFR 41.37 must be filed within two mont of the date of filling the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a). AMENDMENTS 3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filling a brief, will <u>not</u> be entered because (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below); (b) ☐ They arise new issues that would require further consideration and/or search (see NOTE below); (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims. NOTE: (See 37 CFR 1.116 and 41.33(a)). 4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324). 5. ☐ Applicant's reply has overcome the following rejection(s): 6. ☐ Newly proposed or amended claim(s) would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s) would be rejected is provided below or appended. 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation on how the new or amended claims would be rejected is provided below or appended. The status of the claim(s) is (or will be) as follows: Claim(s) objected to: Claim(s) objected to: Claim(s) objected to: Claim(s) objected to: Claim(s) objected to:<th>this application, applicant must timely file one of the follor places the application in condition for allowance; (2) a Not (3) a Request for Continued Examination (RCE) in comp following time periods: a) The period for reply expiresmonths from the mailing of the period for reply expires on: (1) the mailing date of this Advevent, however, will the statutory period for reply expire later the Examiner Note: If box 1 is checked, check either box (a) or (b). MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f) Extensions of time may be obtained under 37 CFR 1.136(a). The date on been filed is the date for purposes of determining the period of extension a CFR 1.17(a) is calculated from: (1) the expiration date of the shortened stabove, if checked. Any reply received by the Office later than three months earned patent term adjustment. See 37 CFR 1.704(b).</th><th>owing replies: (1) an amendment, a otice of Appeal (with appeal fee) in diance with 37 CFR 1.114. The replicate of the final rejection. This ory Action, or (2) the date set forth in the an SIX MONTHS from the mailing date of the CHECK BOX (b) WHEN THE FI (b). Which the petition under 37 CFR 1.136(a and the corresponding amount of the fee. atutory period for reply originally set in the</th><th>ffidavit, or other evide compliance with 37 (y must be filed within e final rejection, whichever the final rejection. RST REPLY WAS FILE) and the appropriate extension of (2)</th><th>ence, which CFR 41.31; or n one of the er is later. In no D WITHIN TWO ension fee have on fee under 37 n as set forth in (b)</th>	this application, applicant must timely file one of the follor places the application in condition for allowance; (2) a Not (3) a Request for Continued Examination (RCE) in comp following time periods: a) The period for reply expiresmonths from the mailing of the period for reply expires on: (1) the mailing date of this Advevent, however, will the statutory period for reply expire later the Examiner Note: If box 1 is checked, check either box (a) or (b). MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f) Extensions of time may be obtained under 37 CFR 1.136(a). The date on been filed is the date for purposes of determining the period of extension a CFR 1.17(a) is calculated from: (1) the expiration date of the shortened stabove, if checked. Any reply received by the Office later than three months earned patent term adjustment. See 37 CFR 1.704(b).	owing replies: (1) an amendment, a otice of Appeal (with appeal fee) in diance with 37 CFR 1.114. The replicate of the final rejection. This ory Action, or (2) the date set forth in the an SIX MONTHS from the mailing date of the CHECK BOX (b) WHEN THE FI (b). Which the petition under 37 CFR 1.136(a and the corresponding amount of the fee. atutory period for reply originally set in the	ffidavit, or other evide compliance with 37 (y must be filed within e final rejection, whichever the final rejection. RST REPLY WAS FILE) and the appropriate extension of (2)	ence, which CFR 41.31; or n one of the er is later. In no D WITHIN TWO ension fee have on fee under 37 n as set forth in (b)
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 7.	 (a) ☐ They raise new issues that would require further co (b) ☐ They raise the issue of new matter (see NOTE below (c) ☐ They are not deemed to place the application in being appeal; and/or (d) ☐ They present additional claims without canceling a NOTE: (See 37 CFR 1.116 and 41.33(a)). 4. ☐ The amendments are not in compliance with 37 CFR 1.15. ☐ Applicant's reply has overcome the following rejection(see Newly proposed or amended claim(s) would be a 	ensideration and/or search (see NO ow); tter form for appeal by materially recorresponding number of finally number of finally recorresponding number of finally num	TE below); educing or simplifying jected claims. ompliant Amendment	the issues for t (PTOL-324).
 8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e). 9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1). 	7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows: Claim(s) allowed: Claim(s) objected to: Claim(s) rejected: 1-3,6,8,9 and 13-36. Claim(s) withdrawn from consideration:	☐ will not be entered, or b) ☑ wovided below or appended.	ill be entered and an	explanation of
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).	 The affidavit or other evidence filed after a final action, be because applicant failed to provide a showing of good an 	ut before or on the date of filing a N nd sufficient reasons why the affida	Notice of Appeal will <u>r</u> vit or other evidence	not be entered is necessary
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.	 The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to a showing a good and sufficient reasons why it is necessar The affidavit or other evidence is entered. An explanation 	overcome <u>all</u> rejections under apperry and was not earlier presented. S	al and/or appellant fa See 37 CFR 41.33(d)(ails to provide a (1).

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____13. Other: _____.

AU1632

See Continuation Sheet.

11.

The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Continuation of 11. does NOT place the application in condition for allowance because: The amendments to the claims and Applicants' arguments have been considered but are not found persuasive. The prior rejections of record are maintained. Because no terminal disclaimer has been filed, the prior rejection, for obviousness-type double patenting, over claims 62-63 of US Application. No. 09/530,346 (now U.S. Pat. No. 6,800,480) is maintained for reasons of record. Applicants argue that the '480 patent does not explicitly claim genetically altered cells cultured on an extracellular matrix, in a medium cultured by fibroblast feeder cells. Further, Applicants argue that there are other ways of producing genetically altered pPS cells, and provide several methods. See p. 7 of the Response. This is not persuasive. Firstly, the instant claims, which are directed to both products and methods of making those products, are obvious over the products of the '480 claims, because the '480 cells encompass cells that are cultured on an extracellular matrix and cultured in a medium cultured by fibroblast feeder cells. Furthermore, the instant product claims (see claim 8, for example) fail to differentiate from the '480 claims, as there is no recitation of extracellular matrix or medium cultured by fibroblast feeder cells. Thus, instant claims are rendered obvious because they are broader than the '480 claims. Finally, specific review of the '480 prosecution history shows that the methods disclosed indicate that a conditioned medium is used to culture the cells. Thus, it is maintained that the instant claims are rendered obvious over claims 10-11 of the '480 patent.

The 112, 1st rejection, for enablement, is maintained for claims 8, 9, 13, 15,16, 18, 19, 25-36 is maintained for reasons of record. The rejection of the method claims (1-3, 6, 17,20-24) is withdrawn in view of Applicants' amendment, reciting that the medium is conditioned by fibroblast feeder cells. Applicants argue that the prior rejection should be withdrawn for all of the claims because, as amended, the rejection is overcome. See pp. 6-7 of the Response. The claims that are maintained in this rejection do not recite that they are cultured on an extracellular matrix and in the presence of media conditioned by fibroblast feeder cells. Thus, the prior rejection of record is maintained, that the specification fails to provide any teachings or guidance for culturing hES cells in a culture environment without fibroblast conditioned medium, without an extracellular matrix. The claims require that the cells remain undifferentiated after transfection. The specification provides no teachings/guidance with regard to specific conditions such that hES cells would remain undifferentiated after transfection except when cultured on an extracellular matrix and in the presence of fibroblast-conditioned medium.